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PATENT LEGAL STAFF
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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended the specification, and amended Claims 1, 10, 17, 18, 20, 44, 53, 59, 62, and 71. All pending claims (1-76) were examined in this non-final office action.

Response to Arguments

Applicant's arguments, see Remarks, filed 24 November 2003, with respect to the rejection(s) of claim(s) 1-76 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of PhotoNet (www.photonet.com), Internet Archive, all pages cited are dated on or before 02 December 1998). PhotoNet teaches a system and method for users accessing a web site to store, view, organize online photographic images, and to share images online with third-parties (e.g. friends, family members).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. Regarding at least Claims 10 and 11 by example, the phrase "goods and/or services" does not clearly set forth the metes and bounds of the patent protection desired. For examination purposes, the phrase "goods and/or services" was assumed to be "goods and services." Please take appropriate action to correct all (with emphasis) instant claims claiming "goods and/or services."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-6, 8, 10-13, and 15 are rejected under 35 USC 102(b) based upon a public use or sale of the invention.

PhotoNet (PTO-892, Item: U) teaches all the limitations of Claims 1, 3-6, 8, 10-13, and 15. For example, PhotoNet discloses a system and method that allows online users to access a web site (www.photonet.com), store, view, organize, share, and download a plurality of images obtained from rolls of photographic film forwarded to photofinishers for processing (Item: see pages 1-17). PhotoNet further discloses:

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- Database: Storing digital images on large servers (Item: U, see at least pages 1 and 4); Archive images for up to 100 years (Item: U, page 7).
- Digital images associated with customer account: Customer submitting a roll of film to a PhotoNet retailer for processing, customer requesting PhotoNet services, customer picking up processed roll of film (e.g. prints) from the retailer, receiving film ID (also referred to as a personal access code, one film ID per roll) to access the customer's online photos (Item: U, see at least pages 1 ("Login to View Your Photos"), 3-4, 8, and 17).
- Automatically providing a product: Customer automatically receiving an e-mail message when the product order is ready to be picked up (Item: U, see at least pages 3-4); Customer automatically receiving both a physical product (prints) and electronic product (digital images) if PhotoNet services are checked prior to the system receiving the film for processing (Item: U, page 3-4); Customer automatically receiving a floppy diskette product (PhotoNet Disk) containing an entire roll of digital images if checked (Item: U, page 16).
- Delivery to a recipient designated by customer: Customer submitting a roll of film for processing designates a recipient for prints and provides an email address of intended recipient of product; Customer designating an email recipient and sends online photos to the intended recipient (Item: U, pages 5, 14, and 17).

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- After pre-determined criteria (number of images): Customer submitting a roll of film with one or more exposed images for processing (pre-determined prior to receipt of digital images), the roll having a pre-determined number of exposable images (Item: U, see at least pages 3-4) (please note examiner's interpretation based on disclosure as noted above regarding PhotoNet Disk: customer receives PhotoNet Disk after pre-determined number of digital images are stored on the disk up to a maximum number of exposures contained on the roll).
- Pre-determined criteria (providing product based on time): Processing the film the day the film is received, the recipient receiving an e-mail message; mailing back prints to the recipient the same day (Item: U, see at least page 10).
- Image scans: PhotoNet retailers producing high resolution image scans; Customer selecting "Scan to Internet" option (Item: U, see at least pages 6 and 9).
- System management: Online PhotoCenter managing a web site for Internet users to access their digital images stored on large servers in multiple locations connected to the Internet; uses Netscape servers to provide World Wide Web access (Item: U, see at least pages 1 and 4).
- Development center: Development center processes film (Item: U, see at least page 8).

- Fulfillment: Producing a diskette containing the customer's digital images obtained from a processed roll of film, and providing the physical product to the customer (Item: U, page 16).
- Electronic album: Providing at least one album page containing digital images (Item: U, see at least page 8).
- Film role ID: Providing a unique identification code for each roll of processed film submitted by the customer (Item: U, see at least page 8).
- Grouping IDs: Grouping online rolls to "make them easy to find" (Item: U, page 17) (please note interpretation by examiner's example: a customer has four rolls of film processed and receives a unique film ID for each roll. The act of combining all four rolls creates a group; the act of combining two or three rolls together creates subgroups from the possible group of four rolls).
- Sharing digital images with a third-party: Customer sharing images with a third-party (e.g. friend, family member) by selecting images and sending intended recipient an e-mail containing attached digital images Item: U, pages 4-5, 9, 14, and 17).
- Third-party access to account: providing a third-party the access code so they may view digital images (Item: U, pages 4-5, 9, 14, and 17).
- Online ordering: Friends and relatives ordering their own prints without using the customer as the intermediary (Item: U, page 6).

- Entering name and unique ID: Customer enters online name and film ID to view online photos (Item: U, pages 4 and 8).
- Entering customer information online: name, access codes (Item: U, see at least pages 8-10, and 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 2 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U), in view of Florida Times Union (Paper #12, PTO-892, Item: U), as applied to Claim 1, further in view of Item Processing Report (PTO-892, Item: UU, hereinafter referred to as "IPR").**

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet (www.kodak.photonet.com) competing against archival Fuji Photo Film's Fujifilm.net (www.fujifilm.net). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper

#12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

PhotoNet and Florida Times Union teach all the above as noted under the 103(a) rejection and teach storing digital images scanned from a roll of film onto a compact disk during a time period predetermined by the system, but do not disclose a predetermined criteria comprising a predetermined time period. IPR teaches storing digital images onto compact disk, and further teach the "customer can receive their digital images on a daily, weekly, or monthly compact disk." (Item: UU, see at least page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method PhotoNet and Florida Times Union to associate predetermined criteria comprising a time period as taught by IPR, in order to base goods and services on a predetermined time period, and thereby attract customers to the service.

4. Claims 7 and 9 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U), in view of Bloom (PTO-892, Item: V).

PhotoNet teaches all the above as noted under the 102(b) rejection but does not disclose automatically providing a subsequent roll of photographic film.

Bloom teaches PhotoNet, digital photography, and companies competing against

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PhotoNet in online photo services. Bloom teaches Filmworks developing photographic film as slides, prints, or digital copies, offering competitive prices, and optionally returning digitized pictures on a floppy disk instead of through the Internet. Bloom further teaches the company (Filmworks) sending a free roll of film with each roll it develops (Item: V, see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method PhotoNet to automatically provide a subsequent roll of film as taught by Bloom, in order to provide additional benefits to the customer, and thereby attract customers to the service.

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches downloading software used for editing digital images and uploading digital images, but do not disclose allowing the customer to modify at least one image prior to providing the product. Bloom teaches Sony's offering development and digitization services from its ImageStation service. Bloom teaches a user editing a digital image, submitting to ImageStation on PhotoNet and either receiving a physical product (prints) or electronic product (digital image) (Item: V, see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method PhotoNet to include image editing prior to receiving a product as taught by Bloom, in order to permit customers to enhance the quality of the photographic image before receiving a product, and thereby attract customers to the service.

- 5. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U), in view of Florida Times Union (Paper #12, PTO-892, Item: U).**

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet (www.kodak.photonet.com) competing against archrival Fuji Photo Film's Fujifilm.net (www.fujifilm.net). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of PhotoNet to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

- 6. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U), in view of Shiota et al. (Paper #6, patent number 6,324,521), as applied to Claim 10, further in view of Official Notice (regarding photo albums).**

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PhotoNet teaches all the above as noted under the 102(b) rejection and teaches providing an online photo album displaying a plurality of digital images on a page, and further teaches providing online ordering of printed products (e.g. extra prints, photo gift items), but do not disclose providing a printed album page. Shiota et al. teach a network photographic service providing online storage of digital images and printing services. Shiota et al. further teach printing services that arrange ordered pictures in an album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose printed photo albums as taught by Shiota et al., in order to generate additional revenue from printed services.

PhotoNet and Shiota et al. teach all the above as noted under the 103(a) rejection and teach a plurality of printed pictures being arranged in a photo album but do not disclose a plurality of images on both sides of an album page. This examiner takes the position that it is old and well known that photo albums pages are designed for double-sided arrangements of pictures to maximize picture content for a given album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to arrange printed pictures on both sides a photo album page as taught by Official Notice, in order to maximize the number of arranged pictures for a given album.

- 7. Claims 17-26, 30-34, 36-37, 40, 42, 44-45, 48-49, 51, 53-54, 58-60, 62-66, 69, 71, and 73-74 are r j cted under 35 USC 103(a) as being unpatentabl**

over PhotoNet (PTO-892, Item: U), in view of Komiya et al. (Paper #6, patent number 6,155,025).

PhotoNet teaches an online system and method that allows online users to access a web site (www.photonet.com), store, view, organize, share, and download a plurality of images obtained from rolls of photographic film forwarded to photofinishers for processing (Item: U, pages 1-18). PhotoNet further teaches:

- Database: Storing digital images on large servers (Item: U, see at least pages 1 and 4); Archive images for up to 100 years (Item: U, page 7).
- Digital images associated with customer account: Customer submitting a roll of film to a PhotoNet retailer for processing, customer requesting PhotoNet services, customer picking up processed roll of film (e.g. prints) from the retailer, receiving film ID (also referred to as a personal access code, one film ID per roll) to access the customer's online photos (Item: U, see at least pages 1 ("Login to View Your Photos"), 3-4, 8, and 17).
- Automatically providing a product: Customer automatically receiving an e-mail message when the product order is ready to be picked up (Item: U, see at least pages 3-4); Customer automatically receiving both a physical product (prints) and electronic product (digital images) if PhotoNet services are checked prior to the system receiving the film for processing (Item: U, page 3-4); Customer automatically receiving a floppy diskette product (PhotoNet Disk) containing an entire roll of digital images if checked (Item: U, page 16).

- *Delivery to a recipient designated by customer*: Customer submitting a roll of film for processing designates a recipient for prints and provides an email address of intended recipient of product; Customer designating an email recipient and sends online photos to the intended recipient (Item: U, pages 5, 14, and 17).
- *After pre-determined criteria (number of images)*: Customer submitting a roll of film with one or more exposed images for processing (pre-determined prior to receipt of digital images), the roll having a pre-determined number of exposable images (Item: U, see at least pages 3-4) (please note examiner's interpretation based on disclosure as noted above regarding PhotoNet Disk: customer receives PhotoNet Disk after pre-determined number of digital images are stored on the disk up to a maximum number of exposures contained on the roll).
- *Pre-determined criteria (providing product based on time)*: Processing the film the day the film is received, the recipient receiving an e-mail message; mailing back prints to the recipient the same day (Item: U, see at least page 10).
- *Image scans*: PhotoNet retailers producing high resolution image scans; Customer selecting "Scan to Internet" option (Item: U, see at least pages 6 and 9).
- *System management*: Online PhotoCenter managing a web site for Internet users to access their digital images stored on large servers in

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multiple locations connected to the Internet; uses Netscape servers to provide World Wide Web access (Item: U, see at least pages 1 and 4).

- Development center: Development center processes film (Item: U, see at least page 8).
- Fulfillment: Producing a diskette containing the customer's digital images obtained from a processed roll of film, and providing the physical product to the customer (Item: U, page 16).
- Electronic album: Providing at least one album page containing digital images (Item: U, see at least page 8).
- Film role ID: Providing a unique identification code for each roll of processed film submitted by the customer (Item: U, see at least page 8).
- Grouping IDs: Grouping online rolls to "make them easy to find" (Item: U, page 17) (please note interpretation by examiner's example: a customer has four rolls of film processed and receives a unique film ID for each roll. The act of combining all four rolls creates a group; the act of combining two or three rolls together creates subgroups from the possible group of four rolls).
- Sharing digital images with a third-party: Customer sharing images with a third-party (e.g. friend, family member) by selecting images and sending intended recipient an e-mail containing attached digital images (Item: U, pages 4-5, 9, 14, and 17).

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- Third-party access to account: providing a third-party the access code so they may view digital images (Item: U, pages 4-5, 9, 14, and 17).
- Online ordering: Friends and relatives ordering their own prints without using the customer as the intermediary (Item: U, page 6).
- Entering name and unique ID: Customer enters online name and film ID to view online photos (Item: U, pages 4 and 8).
- Entering customer information online: name, access codes (Item: U, see at least pages 8-10, and 14).

Obtaining film roll ID from the film roll cartridge or film strip

PhotoNet teaches all the above as noted under the 103(a) rejection and teaches the customer receiving a unique film roll ID for each roll processed, but does not disclose obtaining the roll ID from each film roll cartridge or film strip (image retaining device). Komiya et al. teach a system and method of Fuji Photo Film Company packaging photographic film as an individually packaged roll of film, each packaged roll of film having a unique ID number printed in barcode and human readable characters on the film cartridge and the package, and further teach reading the barcode to obtain the film roll ID (see at least abstract; Fig. 2 (10, 14b, 32, 26, 40a, 40b); Fig. 21 (306b, 310b); col. 9, line 66 through col. 10, line 27; col. 11, lines 18-25; col. 16, lines 48-64; col. 20, lines 36-47; col. 22, lines 22-64). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet to obtain the ID from each roll of film by reading the barcode on the image retaining device as

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taught by Komiya et al., in order to provide a unique ID for each roll of film submitted by the customer.

Obtaining group roll ID

PhotoNet teaches all the above as noted under the 103(a) rejection and teaches providing a customer with a unique film roll ID for each roll submitted for processing and online viewing, and grouping two or more unique film roll IDs into subgroups or groups to make online viewing easier, but does not disclose a unique ID for the group. Komiya et al. teach all the above as noted under the 103(a) rejection and teach packaging multiple rolls of film as a single package, each multi-roll package as having a group ID in barcode form and human readable characters that relates to each roll ID in the package, and reading the barcode to obtain the group ID (see at least abstract; Fig. 2 (10, 14b, 32, 26, 40a, 40b); Fig. 21 (306b, 310b); col. 9, line 66 through col. 10, line 27; col. 11, lines 18-25; col. 16, lines 48-64; col. 20, lines 36-47; col. 22, lines 22-64). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet to read a group ID from each package containing a group ID as taught by Komiya et al., in order to obtain a unique ID for the group.

Customer registers film rolls (forwarding film roll ID)

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach a) a customer providing a PhotoNet retailer with film rolls of exposed images for processing and customer information, each film roll

containing barcode and human readable characters identifying the film roll ID, b) the PhotoNet retailer forwarding the film roll ID and film to a photofinisher for processing, and c) the customer entering personal information online (e.g. name). PhotoNet and Komiya et al., however, do not disclose the online customer registering each film roll ID as an online customer registration task. It would have been obvious to one of ordinary skill in the art at time of the invention to shift the complete registration task to the online customer, since it is well within the skill to ascertain that since each customer already submits personal information online and already possesses film roll ID information prior to submitting the exposed film for processing, each customer can submit film roll ID information online as well prior to submitting the exposed film for processing, and therefore reduce administrative burden for PhotoNet retailers.

Customer registers a multi-roll package group online

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach a) a customer providing a PhotoNet retailer with film rolls of exposed images for processing, b) multi-roll film package containing a package ID in barcode and human readable characters that relates to each film roll ID in the package, and c) the customer providing personal information online (e.g. name). PhotoNet and Komiya et al., however, do not disclose the online customer registering the group ID as an online customer registration task. It would have been obvious to one of ordinary skill in the art at time of the invention to shift the complete registration task to the online customer, since it is well within

the skill to ascertain that since each customer already submits personal information online and already possesses the package group ID prior to submitting the exposed film for processing from a multi-roll package, each customer can submit package group ID information online as well prior to submitting the exposed film for processing, and therefore reduce administrative burden for PhotoNet retailers.

Automatically registering a plurality of film rolls based on package group ID

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach a) registering an individual film roll or multi-roll package online, and b) the package ID relating to each individual film roll ID in the package stored in a database (Komiya et al.: see at least col. 22, lines 16-25, 61-64), but do not disclose registering the package group ID as automatically registering the individual rolls of film in the package. It would have been obvious to one of ordinary skill in the art at time of the invention to automatically register the rolls in the multi-roll package, since it is well within the skill to ascertain that registering the package ID that relates to each individual roll ID stored in a database can automatically register each individual roll.

8. **Claim 27 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 20, further in view of Florida Times Union (Paper #12, PTO-892, Item: U).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and further teach providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet (www.kodak.photonet.com) competing against archival Fuji Photo Film's Fujifilm.net (www.fujifilm.net). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of PhotoNet and Komiya et al. to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

9. **Claims 28-29 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 20, further in view Shiotani et al. (Paper #6, patent number 6,324,521), further in view of Official Notice (regarding photo albums).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach providing an online photo album displaying a plurality of digital images, and further teach providing online ordering of printed products

(e.g. extra prints, photo gift items), but do not disclose providing a printed album page. Shiota et al. teach a network photographic service providing online storage of digital images and printing services. Shiota et al. further teach printing services that arrange ordered pictures in an album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose printed photo albums as taught by Shiota et al., in order to generate additional revenue from printed services.

PhotoNet, Komiya et al., and Shiota et al. teach all the above as noted under the 103(a) rejection and teach a plurality of printed pictures being arranged in a photo album but do not disclose a plurality of images on both sides of an album page. This examiner takes the position that it is old and well known that photo albums pages are designed for double-sided arrangements of pictures to maximize picture content for a given album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to arrange printed pictures on both sides a photo album page as taught by Official Notice, in order to maximize the number of arranged pictures for a given album.

- 10. Claim 35 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 34.**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach a) registering an individual film roll or multi-roll package

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online, and b) the package ID relating to each individual film roll ID in the package stored in a database (Komiya et al.: see at least col. 22, lines 16-25, 61-64), but do not disclose registering the package group ID as automatically registering the individual rolls of film in the package. It would have been obvious to one of ordinary skill in the art at time of the invention to automatically register the rolls in the multi-roll package, since it is well within the skill to ascertain that registering the package ID that relates to each individual roll ID stored in a database can automatically register each individual roll.

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection but do not disclose registering one film roll automatically registers the remaining film rolls in the multi-roll package. It would have been obvious to one of ordinary skill in the art at time of the invention to automatically register the remaining rolls in a multi-roll package, since it is well within the skill to ascertain that each film roll ID of the package stored in a database relates to every other film roll ID, and therefore registering one film roll ID automatically registers the remaining film roll IDs.

- 11. Claims 38, 46, and 56 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claims 37, 45, 54, and 66, further in view of Florida Times Union (Paper #12, PTO-892, Item: U), further in view**

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of Item Processing Report (PTO-892, Item: UU, hereinafter referred to as "IPR").

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and further teach providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet (www.kodak.photonet.com) competing against archival Fuji Photo Film's Fujifilm.net (www.fujifilm.net). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of PhotoNet and Komiya et al. to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

PhotoNet, Komiya et al., and Florida Times Union teach all the above as noted under the 103(a) rejection and teach storing digital images scanned from a roll of film onto a compact disk during a time period predetermined by the system, but do not disclose a predetermined criteria comprises a predetermined time period. IPR teaches storing digital images onto compact disk, and further teach the customer can receive their digital images on a daily, weekly, or monthly compact disk. Therefore it would have been obvious to one of ordinary skill in the

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art at time of the invention to modify the system and method PhotoNet, Komiya et al., and Florida Times Union to associate predetermined criteria comprising a time period as taught by IPR, in order to base goods and services on a predetermined time period, and thereby attract customers to the service.

- 12. Claims 39, 47, 57, and 67 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claims 37, 45, 54, and 66.**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach a) storing digital images scanned from a roll of film onto a compact disk based on the number of images obtained from a single roll of film, and b) combining two or more rolls of film images into an image group to "make viewing easier," but do not disclose a predetermined number of images obtained from a group of film rolls. It would have been obvious to one of ordinary skill in the art at time of the invention to base pre-determined criteria on a number of images in a group, since it is well within the skill to ascertain that since combining one or more rolls of images to form a group of images "makes viewing easier," the consequence of basing a compact disk product on a predetermined number of images from a group of images "makes viewing easier."

- 13. Claims 41, 43, 50, 52, 55 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6,**

patent number 6,155,025), as applied to Claims 40, 42, 48, 51, 54, further in view of in view of Bloom (PTO-892, Item: V).

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection but do not disclose automatically providing a subsequent roll of photographic film. Bloom teaches PhotoNet, digital photography, and companies competing against PhotoNet in online photo services. Bloom teaches Filmworks developing photographic film as slides, prints, or digital copies, offering competitive prices, and optionally returning digitized pictures on a floppy disk instead of through the Internet. Bloom further teaches the company (Filmworks) sending a free roll of film with each roll it develops (Item: V, see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method PhotoNet and Komiya et al. to automatically provide a subsequent roll of film as taught by Bloom, in order to provide additional benefits to the customer, and thereby attract customers to the service.

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and further teach downloading software used for editing digital images and uploading digital images, but do not disclose allowing the customer to modify as least one image prior to providing said product. Bloom teaches Sony's offering development and digitization services from its ImageStation service. Bloom teaches a user editing a digital image, submitting to ImageStation on PhotoNet and either receiving a physical product (prints) or electronic product (digital image) (Item: V, see at least page 2). Therefore it would have been obvious to

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one of ordinary skill in the art at time of the invention to modify the method PhotoNet and Komiya et al. to include image editing prior to receiving a product as taught by Bloom, in order to permit customers to enhance the quality of the photographic image before receiving a product, and thereby attract customers to the service.

- 14. Claim 61 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 59, further in view of in view of Egan (Paper #12, patent number 6,273,986).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and further teach printing unique film roll IDs on packages, but do not disclose a removable label that hides the ID. Egan teaches composite labels, package labeling systems and methods where the composite label serves as a combination of shipping label and packing list label with the shipping bar code indicia or other suitable indicia used for tracking purposes and identifying the contents of the package noted on the packing list (see at least abstract; col. 2, lines 32-36; col. 4, lines 18-22). Egan teaches the user removes the shipping label to reveal the packing list that identifies package contents (see at least col. 3, lines 22-51). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet and

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Komiya et al. to incorporate a removable label with hidden indicia as taught by Egan, in order to hide the unique roll ID information.

- 15. Claim 68 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 63, further in view of Florida Times Union (Paper #12, PTO-892, Item: U).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and further teach providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet (www.kodak.photonet.com) competing against archival Fuji Photo Film's Fujifilm.net (www.fujifilm.net). Florida Times Union further teaches many film processors offering the option of having 1 pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of PhotoNet and Komiya et al. to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

- 16. Claim 70 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 69, further in view of Shiota et al. (Paper #6, patent number 6,324,521), further in view of Official Notice (regarding photo albums).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and teach providing an online photo album displaying a plurality of digital images on a page, and further teaches providing online ordering of printed products (e.g. extra prints, photo gift items), but do not disclose providing a printed album page. Shiota et al. teach a network photographic service providing online storage of digital images and printing services. Shiota et al. further teach printing services that arrange ordered pictures in an album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose printed photo albums as taught by Shiota et al., in order to generate additional revenue from printed services.

PhotoNet, Komiya et al. and Shiota et al. teach all the above as noted under the 103(a) rejection and teach a plurality of printed pictures being arranged in a photo album but do not disclose a plurality of images on both sides of an album page. This examiner takes the position that it is old and well known that photo albums pages are designed for double-sided arrangements of pictures to maximize picture content for a given album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to arrange

printed pictures on both sides a photo album page as taught by Official Notice, in order to maximize the number of arranged pictures for a given album.

- 17. Claims 72 and 75 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U) and Komiya et al. (Paper #6, patent number 6,155,025), as applied to Claim 71, further in view of Lipton (PTO-892, Item: W).**

PhotoNet and Komiya et al. teach all the above as noted under the 103(a) rejection and a) teach the customer or photo retailer registering the film and providing a film ID number, and b) further teach a film manufacturer shipping product, finding a quality failure in a photographic film cartridge after it has been sold, recalling product having the same production history, tracing product while in distribution using the film ID number, and storing film ID and product history information in a database (Komiya et al.: see at least col. 22, lines 16-25, 61-64), but does not disclose the manufacturer forwarding the film roll ID to a network photo service provider. Lipton teaches tracing manufactured goods (e.g. photographic products) using at least product serial numbers stored in a database to track manufactured product as it moves through the distribution chain (e.g. distributors, wholesalers, retailers, consumers). Lipton teaches a system and method of integrating product traceability into an inventory control system for supporting product recalls and other customer service benefits. Lipton further teaches linking each product code to a customer's name, address, and

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phone number. (Item: W, see at least pages 4-10). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet and Komiya et al. to forward at least one film ID number to a manufacturer's distribution chain representative as taught by Lipton, in order to permit automatic access to product serial number information.

PhotoNet, Komiya et al., and Lipton teach all the above as noted under the 103(a) rejection and teach a) forwarding film roll ID information to a network photo service provider from a customer or retailer, and b) a manufacturer (e.g. photography products) registering product serial numbers in a database for dissemination to its distribution chain, but do not disclose forwarding a product serial number to a network photo service provider. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a network photo service provider as a member of a manufacturer's distribution chain, since it is well within the skill to ascertain that consumers of photographic film are dependent on network photo service providers to complete the processing of exposed film in order for customer to derive benefit from their purchase of photographic film.

- 18. Claim 76 rejected under 35 USC 103(a) as being unpatentable over PhotoNet (PTO-892, Item: U), Komiya et al. (Paper #6, patent number 6,155,025), and Lipton (PTO-892, Item: W), as applied to Claim 74, further in view of Automatic ID Numbers (PTO-892, Item: X).**

PhotoNet, Komiya et al., and Lipton teach all the above as noted under the 103(a) rejection and teach customer's registering for an online account or in-store, but do not disclose scanning a registration card. Automatic ID News teaches issuing magnetic striped membership cards (please note the examiner interprets a membership card to be similar to a registration card) to eliminate manual entry of member information stored in a database, swiping cards (please note the examiner interprets swiping a magnetic card to be the same as scanning a magnetic card) for information, and further teaches accessing a central database to process member information (Item: X, page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet, Komiya et al., and Lipton to scan a registration card as taught by Automatic ID News, in order to save manual entry of data, and thereby attract uses to the service.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

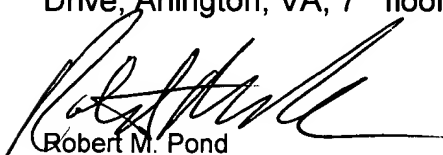
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
February 23, 2004